

REMARKS

Claims 1-25 are pending in the application. Claims 1 and 8 are rejected under 35 U.S.C. §102(e). Claims 2-7 and 9-14 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 15-25 are allowed. Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

I. REJECTIONS UNDER 35 U.S.C. § 102(e):

The Office Action has rejected claims 1 and 8 under 35 U.S.C. §102(e) as being anticipated by Holloway et al. (U.S. Patent No. 6,747,996) (hereinafter "Holloway"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Holloway does not disclose "a host Ethernet media controller and an HPNA chip" as recited in claim 1 and similarly in claim 8. The Examiner cites element 52 of Holloway as disclosing a host Ethernet media controller and element 46b of Holloway as disclosing an HPNA chip. Paper No. 3, page 2. Applicants respectfully traverse the assertion that Holloway discloses the above-cited claim limitation. Instead, Holloway discloses a telephone handset connected to a terminal which consists in part of a voice codec which converts between analog signals and sampled data signals at a sample rate as well as consists of a HPNA network interface 46a which assembles the voice samples into a packet which is then transmitted on an HPNA network to a gateway. Column 2, lines 29-36. Holloway further discloses that the gateway receives a HPNA packet at the

counterpart HPNA network I/F 46b and queues it for transmission by Wide Area Network (WAN) interface 52. Column 2, lines 36-39. There is no language in Holloway that describes a wide area network interface as being equivalent to a host Ethernet media access controller as asserted by the Examiner. The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that WAN interface 52 discloses a host Ethernet media access controller. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that WAN interface 52 discloses a host Ethernet media access controller, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner is merely relying upon his own subjective opinion which is insufficient to establish a *prima facie* case of anticipation. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); M.P.E.P. §2131. Thus, Holloway does not disclose all of the limitations of claims 1 and 8, and thus Holloway does not anticipate claims 1 and 8. M.P.E.P. §2131.

Applicants further assert that Holloway does not disclose "wherein control frame and data frame pairs are transferred between the host Ethernet media access controller (MAC) and the HPNA chip" as recited in claim 1 and similarly in claim 8. The Examiner cites Figure 17 and column 3, lines 11-13 of Holloway as disclosing the above-cited claim limitation. Paper No. 3, page 2. Applicants respectfully traverse and assert that Holloway instead discloses that a synchronization protocol is established between a synchronous terminal and a synchronous end point by providing a gateway between the asynchronous communications network and the synchronous end point. Column 3, lines 5-8. Holloway further discloses that the gateway communicates with the synchronous terminal over the asynchronous communications network in accordance with the synchronization protocol. Column 3, lines 8-11. Holloway further discloses that the synchronization protocol includes sending a message (referred to as the "SP packet") from the gateway to the synchronous terminal where the SP packet contains a timestamp identifying a clock associated with the synchronous end point. Column 3, lines 11-15. Hence, Holloway

discloses sending a packet that contains a timestamp from the gateway to the synchronous terminal. The Examiner has not provided any evidence that the SP packet that contains a timestamp discloses a control frame or a data frame or a control frame and data frame pair. The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the SP packet that contains a timestamp discloses a control frame or a data frame or a control frame and data frame pair. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that the SP packet that contains a timestamp discloses a control frame or a data frame or a control frame and data frame pair, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner is merely relying upon his own subjective opinion which is insufficient to establish a *prima facie* case of anticipation. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002); M.P.E.P. §2131. Thus, Holloway does not disclose all of the limitations of claims 1 and 8, and thus Holloway does not anticipate claims 1 and 8. M.P.E.P. §2131.

Furthermore, in connection with the rejection of the claim limitation recited in the above paragraph, the Examiner cites to the voice packet disclosed in Figure 17 as disclosing a data frame and to the SP packet disclosed in Figure 17 as disclosing a control frame. Paper No. 3, page 2. The Examiner has not provided any evidence that the SP packet and voice packet are pairs as required by the language recited in the above-recited claim limitation. Thus, Holloway does not disclose all of the limitations of claims 1 and 8, and thus Holloway does not anticipate claims 1 and 8. M.P.E.P. §2131.

Applicants further assert that Holloway does not disclose "sending a null frame from the host Ethernet MAC to the HPNA chip prior to the data frame" as recited in claim 1 and similarly in claim 8. The Examiner cites Figure 17 and column 8, lines 3-7 of Holloway as disclosing the above-cited claim limitation. Paper No. 3, page 3. Applicants respectfully traverse and assert that Holloway instead discloses that if three packetized voice stations are active, then the gateway would signal in the

SP packet that station 1 should preload its Backoff Level (BL) with 1, that station 2 should preload with 0 and that station 3 should preload with 2. There is no language in the cited passage that discloses sending a null frame. Neither is there any language in the cited passage that discloses sending a null frame from a host Ethernet MAC to the HPNA chip. Neither is there any language in the cited passage that discloses sending a null frame from the host Ethernet MAC to the HPNA chip prior to a data frame. Thus, Holloway does not disclose all of the limitations of claims 1 and 8, and thus Holloway does not anticipate claims 1 and 8. M.P.E.P. §2131.

Applicants further assert that Holloway does not disclose "recognizing the null frame on the HPNA chip as an indication that a next received frame will be the data frame, thereby maintaining synchronization between the control frame and the data frame pairs" as recited in claim 1 and similarly in claim 8. The Examiner cites Figure 17 and column 8, lines 3-7 of Holloway as disclosing the above-cited claim limitation. Paper No. 3, page 3. Applicants respectfully traverse. As stated above, Holloway instead discloses that if three packetized voice stations are active, then the gateway would signal in the SP packet that station 1 should preload its Backoff Level (BL) with 1, that station 2 should preload with 0 and that station 3 should preload with 2. There is no language in the cited passage that discloses sending a null frame. Neither is there any language in the cited passage that discloses recognizing the null frame on a HPNA chip. Neither is there any language in the cited passage that discloses recognizing the null frame on a HPNA chip as an indication that a next received frame will be the data frame. Neither is there any language in the cited passage that discloses maintaining synchronization between the control frame and the data frame pairs. Thus, Holloway does not disclose all of the limitations of claims 1 and 8, and thus Holloway does not anticipate claims 1 and 8. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Holloway, and thus claims 1 and 8 are not anticipated by Holloway.

**II. ALLOWABLE SUBJECT MATTER:**

Applicants thank the Examiner for the allowance of claims 15-25. Applicants further thank the Examiner for the indication of allowability of claims 2-7 and 9-14.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-25 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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